

**REMARKS**

Please reconsider this application in view of the above amendments and following remarks. Applicant thanks the Examiner for carefully considering this application.

**Disposition of the Claims**

Claims 1, 2, 4, 5, 7, and 8 are currently pending in this application. Claims 1 and 4 are independent. The remaining claims depend, directly or indirectly, from the independent claims.

**Amendments to the Claims**

By way of this reply, claims 1, 2, 4, 7, and 8 have been amended. Claims 1 and 4 have been amended to recite, in part, “the copy condition information can be changed in accordance with an operation performed by the user,” which is supported by, *e.g.*, paragraph [0056] of the published specification. Claim 2 has been amended to correct minor informalities. Claims 7 and 8 have been amended to recite, in part, “when the calculated predicted time exceeds a stipulated time which the user can set, insufficient memory notification information is transmitted, and when the calculated predicted time is equal to or less than the stipulated time and an elapsed time since an execution time of calculating the predicted time matches the predicted time, the copy control processing is executed,” which is supported by, *e.g.*, paragraphs [0078]-[0086]. No new matter has been added by way of these amendments.

**Rejections under 35 U.S.C. § 103(a)****Claims 1, 2, 4, and 5**

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patent No. 6,947,165 (“Kataoka”) in view of U.S. Patent No. 6,469,795

(“Beaudet”). To the extent this rejection may still apply to the amended claims, the rejection is respectfully traversed.

MPEP § 706.02(j) provides, “to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Further, in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. Hence, the key to supporting any rejection under § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See MPEP §§ 2141, 2142.

Applicant respectfully maintains that the arguments set forth in the reply filed on November 6, 2008, sufficiently demonstrate the patentability of the pending claims over the cited references. Nonetheless, in order to further clarify the distinction between the claimed invention and the cited references, particularly Kataoka, the claims have been amended by way of this reply. Amended independent claim 1 recites, in part, “the operation unit enables the user to set a copy condition and transmits information containing copy condition information representing the copy condition set by the user as the interrupt copy start command information, the copy control means of the printer calculates the capacity of an available storage area required for executing the copy control processing based on the copy condition information contained in the interrupt start command information, and the copy condition information can be changed in accordance with an operation performed by the user.” Amended independent claim 4 recites substantially similar limitations. Applicant respectfully asserts that the cited references, whether considered separately or in combination, fail to show or suggest at least these limitations.

In the “Response to Arguments” section of the instant Office Action, the Examiner made the following arguments:

Kataoka discloses having a user set a copy condition, such as setting various settings, during the interruption for outputting the image data (See Col. 3, Lines 2-6). As a result, the memory is analyzed to determine whether there is sufficient room required to execute the copy processing (See Col. 5, Lines 34-36). Once it is determined that the capacity is sufficient, the copy processing is executed (See Col. 5, Lines 35-36 and Lines 2-3). Thus, the prior art of Kataoka does meet the limitations of the claims as disclosed within the rejection above.

However, as explained in detail below, Applicant respectfully notes that the Examiner’s arguments are based on an unsupported assumption that the process of Kataoka, *i.e.*, *determining available memory capacity based on a prescribed value*, is functionally equivalent to the process of the claimed invention, *i.e.*, *calculating available memory capacity based on copy condition information set by a user*. Furthermore, Kataoka is completely silent regarding the limitation that “the copy condition information can be changed in accordance with an operation performed by the user.” Therefore, despite the Examiner’s arguments, Applicant respectfully asserts that Kataoka does not disclose at least the aforementioned limitations of amended independent claims 1 and 4.

In support of the rejection, the Examiner cited col. 3, lines 2-6 of Kataoka, which states: “[d]uring the interruption, possible are copying, image data transmission . . . , printing of image stored in the image memory and administrative information, various setting and the like.”

The Examiner also cited col. 5, lines 27-33 of Kataoka, which states: “it is determined at S46 whether printing based on the remaining capacity of the image memory 21 should be executed or not . . . A user may set such printing beforehand. . . [T]hen it is determined whether the remaining capacity of the image memory 21 is less than a prescribed value at S47.” Applicant respectfully asserts that these teachings do not show or suggest at least the aforementioned limitations of amended independent claims 1 and 4.

Specifically, Applicant notes that the process of determining available memory capacity *based on a prescribed value*, as disclosed in Kataoka, is functionally distinct from the process of calculating available memory capacity *based on copy condition information set by a user* as required by the claimed invention. In other words, the Examiner incorrectly interprets “a prescribed value,” as disclosed in Kataoka, to be the functional equivalent of “a copy condition set by the user,” as required by amended independent claims 1 and 4. Such an interpretation is not supported by Kataoka or any of the other cited references. *See MPEP § 2141* (“Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.”). Furthermore, the Examiner has not articulated any reasons with rational underpinnings that would support such an interpretation. *See MPEP § 2141* (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). Hence, Applicant respectfully asserts that the aforementioned limitations of amended independent claims 1 and 4 are distinct from the teachings of Kataoka.

Moreover, Applicant respectfully points out that “calculating” available memory capacity, as required by amended independent claims 1 and 4, is not the same as merely determining whether the available memory capacity is above or below a prescribed value, as taught by Kataoka. Specifically, a “comparison” merely determines whether available memory space is above or below a certain threshold, whereas a “calculation” determines the exact

memory. It is unequivocally clear to a person of ordinary skill in the art that a “calculation” based on a copy condition set by a user is distinct from a mere “comparison” with a prescribed value, and that the two features can have different purposes.

In sum, the Examiner’s implication that a mere *comparison* with a *prescribed value* is the same as a *calculation* based on a *copy condition set by the user* is completely unsupported by the cited references, and, further, none of the prior art references provides any suggestion or motivation for one of ordinary skill in the art to modify the teachings of Kataoka to realize the aforementioned limitations of amended independent claims 1 and 4. For at least these reasons, amended independent claims 1 and 4 are not rendered obvious by Kataoka or any of the other references.

In view of the above, Kataoka and Beaudet, whether considered separately or in combination, fail to show or suggest all the limitations of amended independent claims 1 and 4. Therefore, amended independent claims 1 and 4 are patentable over Kataoka and Beaudet. By virtue of their dependence, the remaining claims are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

#### Claims 7 and 8

Claims 7 and 8 stand rejected under § 103(a) as being unpatentable over Kataoka in view of Beaudet as applied to claims 1 and 4, and further in view of U.S. Patent No. 6,449,056 (“Mishima”). To the extent this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As explained above, amended independent claims 1 and 4 are patentable over Kataoka and Beaudet. Because claims 7 and 8 depend from amended independent claims 1 and 4, and because Mishima fails to show or suggest that which Kataoka and Beaudet lack with

respect to those claims, claims 7 and 8 are patentable over Mishima, Kataoka, and Beaudet by virtue of their dependence. In addition, as explained below, the limitations recited in claims 7 and 8 are patentable over the cited references in their own right.

On page 6 of the instant Office Action, the Examiner argued that Mishima discloses that the printer calculates a required memory based on the copy description information and calculates the predicted time when the available memory capacity reaches the required memory capacity. However, as explained above, claims 7 and 8 have been amended to recite, in part, “when the calculated predicted time exceeds a stipulated time which the user can set, insufficient memory notification information is transmitted, and when the calculated predicted time is equal to or less than the stipulated time and an elapsed time since an execution time of calculating the predicted time matches the predicted time, the copy control processing is executed,” which is neither explicitly nor inherently taught by Mishima or the other cited references. Therefore, the cited references fail to show or suggest all the limitations of amended claims 7 and 8.

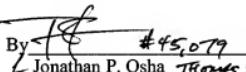
In view of the above, amended claims 7 and 8 are patentable over Mishima, Kataoka, and Beaudet, whether considered separately or in combination. Accordingly, withdrawal of this rejection is respectfully requested.

**Conclusion**

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04995/129001).

Dated: April 30, 2009

Respectfully submitted,

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